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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/667,010	09/21/2000	Uve Hansmann	IBM-116	8803

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EXAMINER	
MOORTHY, ARAVIND K	

ART UNIT	PAPER NUMBER
2131	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/667,010	HANSMANN ET AL.	
	Examiner	Art Unit	
	Aravind K. Moorthy	2131	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 April 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-11* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-11* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *21 September 2000* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This is in response to the RCE filed on 12 April 2007.

2. Claims 1-11 are pending in the application.

3. Claims 1-11 have been rejected.

Continued Examination Under 37 CFR 1.114

4. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12 April 2007 has been entered.

Response to Amendment

5. The examiner approves of the amendment made to independent claims 1 and 11. No new matter has been added. There is support in the specification for the limitation "progressive hierarchies of access rights to said device".

Response to Arguments

6. Regarding the rejection under 35 U.S.C. 112, first paragraph, the Applicant's arguments filed 28 February have been fully considered but they are not persuasive.

On page 1, the applicant argues that the basis for "split key" (i.e. public key/private key procedures) is found inherently in the specification in terms of its description of the invention.

The examiner respectfully disagrees. The applicant has not provided a definition of "split key". The applicant argues that the basis for "split key" is public key/private key procedures. The examiner disagrees. When creating a split key, you are asked to set up how many different

shares that will be required to rejoin the key. The shares are saved as files either encrypted to the public key of a shareholder or encrypted conventionally if the shareholder has no public key. After the key has been split, attempting to sign with it or decrypt with it will automatically attempt to rejoin the key. There are two ways to rejoin a key, locally and remotely. Rejoining key shares locally requires the shareholders presence at the rejoining computer. Each shareholder is required to enter the passphrase for his or her key share. Rejoining key shares remotely requires the remote shareholders to authenticate and decrypt their keys before sending them over the network. Based on this logic, the examiner maintains the rejection under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

7. Regarding the prior art, the Applicant's arguments with respect to claims 1-11 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 1-11 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Independent claims 1 and 11 have been amended to include the limitations of "said authentication comprising temporary deactivation which adds authorization patterns prior to said

operation" and "non split-key". Neither of these limitations are supported by the specification as originally disclosed.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1-4, 10 and 11 are rejected under 35 U.S.C. 102(e) as being anticipated by Clark U.S. Patent No. 5,892,902.

As to claim 1, Clark discloses a method for setting basic means of access for operation of devices of which the operation is controllable by electronic means, comprising:

> the devices comprising mobile phones, small computer-controlled consumer devices with relatively low level of computing power, computers, motor vehicles, control terminals for industrial processes, all of which devices may require authentication prior to operation [column 4, lines 30-53], the authentication comprising temporary deactivation which adds authorization patterns of progressive hierarchies of access rights to the devices prior to the operation [column 6, lines 37-53];
>
> establishment of a non split-key link between a personal authentication system supplied with encryption data and a logic system able to control an

electronic device control, the encryption data being stored solely in the authentication system, the link between the authentication system and the device being via wired or wireless means [column 6, lines 24-36].

checking the encryption data in the authentication system prior to operation of the electronic device control [column 6, lines 24-36];

assignment of a plurality of predetermined means of access to the electronic device control associated with the authentication system the predetermined means providing access to physical hardware resources and access to different software functions, based on the privileges of the user who identified himself to the system, the software function evaluates a security token and is running on top of the physical hardware [column 5, lines 15-38];

enabling of the means for access predetermined for the authentication system dependent on the result of the check [column 5, lines 15-38].

As to claim 2, Clark discloses that the basic means of access to functions of the device comprise at least one of the following means: disable operation of the devices, enable operation of the devices, or enable configuration of the devices [column 5, lines 63-67].

As to claim 3, Clark discloses that the link is made without need for intermediate software layers [column 5, lines 40-47].

As to claim 4, Clark discloses in addition, the step of reading at least one of the following features embodied within the authentication system: firmware programs, device-specific command sequences for execution of specific device-specific functions, cryptographic keys, cryptographic algorithms, and individual decision-making logic [column 6, lines 24-36].

As to claim 10, Clark discloses program code areas for the execution or preparation for execution of the steps when the program is installed in a computer [column 5, lines 40-47].

As to claim 11, Clark discloses a method for setting basic means of access for operation of devices of which the operation is controllable by electronic means, comprising:

the devices comprising computer-controlled consumer devices with relatively low level of computing power, computers, motor vehicles, control terminals for industrial processes, all of which devices may require authentication prior to operation [column 4, lines 30-53] the authentication comprising deactivation which adds authorization patterns of progressive hierarchies of access rights to the devices prior to the operation [column 6, lines 37-53];

establishment of a non split-key link between a personal authentication system supplied with encryption data and a logic system able to control an electronic device control, the encryption data being stored solely in the authentication system, the link between the authentication system and the device being via wired or wireless means [column 6, lines 24-36].

checking the encryption data in the authentication system prior to operation of the electronic device control [column 6, lines 24-36];

assignment of a plurality of predetermined means of access to the electronic device control associated with the authentication system the predetermined means providing access to physical hardware resources and access to different software functions, based on the privileges of the user who identified

himself to the system, the software function evaluates a security token and is running on top of the physical hardware [column 5, lines 15-38];

enabling of the means for access predetermined for the authentication system dependent on the result of the check [column 5, lines 15-38].

the method providing means of no access or full access and allow more finely defined levels of access as defined in a user profile for configuration or maintenance work [column 5, lines 15-38].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claims 5-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clark U.S. Patent No. 5,892,902 as applied to claim 1 above, and further in view of Findikli et al U.S. Patent No. 6,415,144 B1.

As to claim 5, Clark does not teach that the method includes configuration of the devices, by authorized persons. Clark does not teach that after successful authentication, device-specific configuration data are downloaded into the devices from the authentication system in accordance with the authentication systems or over a network.

Findikli et al teaches configuration of the devices, by authorized persons [column 1 line 61 to column 2 line 5]. Findikli et al teaches that device-specific configuration data are

downloaded into the devices from the authentication system in accordance with the authentication systems or over a network [column 1 line 61 to column 2 line 5].

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Clark so that the method would have included configuration of the devices, by an authorized persons. After successful authentication, device-specific configuration data would have been downloaded into the devices from the authentication system in accordance with the authentication systems or over a network.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Clark by the teaching of Findikli et al because over-the-air teleservices provide the radio telecommunications system operators with greater flexibility in tailoring wireless devices to meet the needs of their subscribers [column 2, lines 6-10].

As to claim 6, Clark teaches execution setting basic means of access for operations [column 6, lines 37-53].

As to claim 7, Clark teaches authentication of a person or a group of people [column 5, lines 15-38].

As to claim 8, Clark teaches that the authentication system is implemented in the form of a Smartcard [column 5, lines 15-38].

As to claim 9, Clark teaches setting basic means of access for operation of devices of which the operation is controllable by electronic means, including at least one device and an authentication system [column 5, lines 15-38].

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aravind K. Moorthy whose telephone number is 571-272-3793. The examiner can normally be reached on Monday-Friday, 8:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz R. Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Aravind K Moorthy AM
June 20, 2007

SYED A. ZIA
PRIMARY EXAMINER